

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte CARL SPANA, JOSEPH FARGNOLI,  
and JOSEPH BOLEN

---

Appeal No. 1996-2210  
Application 08/129,722

---

ON BRIEF

---

Before WINTERS, WILLIAM F. SMITH, and LORIN, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner=s decision rejecting claims 1 through 4, 6 through 17, and 22 through 26, which are all of the claims remaining in the application.

Claims 1 and 23, which are illustrative of the subject matter on appeal, read as follows:

1. An expression vector, comprising:

(a) a first coding region, which codes for glutathione-S-transferase, operatively connected to a baculovirus promoter,

(b) a second coding region in-frame with the first coding region, and

(c) a restriction region containing at least one restriction site downstream of the first coding region, into which the second coding region is inserted;

wherein a fusion protein encoded by the first and second coding regions would be produced by expression of the vector.

23. An expression vector, comprising:

(a) a first coding region, which codes for glutathione-S-transferase, operatively connected to a promoter, and

(b) a restriction region downstream of the first coding region having the sequence of SEQ. ID No.:5, which allows for insertion of a second coding region in-frame with the first coding region.

The references relied on by the examiner are:

Ausubel et al. (Ausubel), Short Protocols In Molecular Biology, Second Edition, AA Compendium of Methods from Current Protocols in Molecular Biology,@ John Wiley & Sons, pp. 16-28-16-48 (1992).

PCT (Laroche)

WO 91/16353

Oct. 31, 1991

The issues presented for review are:

(1) whether the examiner erred in rejecting claims 1 through 4, 6 through 17, and 22 under 35 U.S.C. ' 103 as unpatentable over Ausubel; and

(2) whether the examiner erred in rejecting claims 23 through 26 under 35  
U.S.C. ' 103 as unpatentable over the combined disclosures of Ausubel and Laroche.

On consideration of the record, we affirm the rejection of claims 1 through 4, 6  
through 17, and 22. However, we reverse the rejection of claims 23 through 26.

### DISCUSSION

In their Appeal Brief, applicants do not argue the patentability of claims 2  
through 4, 6 through 17, and 22 separately from claim 1. Accordingly, for the purposes of  
this appeal, we shall treat claims 2 through 4, 6 through 17, and 22 as standing or falling  
together with claim 1.

For the reasons succinctly stated by the examiner (Examiner=s Answer, Paper No.  
21, paragraph bridging pages 3 and 4), we conclude that the subject matter sought to be  
patented in claim 1 would have been prima facie obvious in view of Ausubel. It would have  
been prima facie obvious to produce a fusion protein of a desired eukaryotic protein and  
glutathione-S-transferase (GST), using a baculovirus promoter in a baculovirus system, to  
exploit the known advantages of that system and, simultaneously, to permit easy isolation  
of the desired protein using glutathione-agarose beads.

Applicants rely on results presented in their specification, particularly page 17, lines

9 through 11; page 18, lines 23-26; and Figures 3A and 3B, to rebut the prima facie case of obviousness. That reliance is misplaced. It is well settled that objective evidence of non-obviousness must be commensurate in scope with the claims which the evidence is offered to support. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); In re Greenfield, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978); In re Clemens, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980). That is not the case here. For the reasons ably set forth by the examiner (Examiner=s Answer, Paper No. 21, paragraph bridging pages 7 and 8), we find that applicants= evidence of non-obviousness in the specification is not adequately representative or commensurate in scope with claim 1 on appeal. Accordingly, we find that applicants= specification evidence is insufficient to rebut the prima facie case of obviousness.

On these facts, we hold that claim 1, considered as a whole, would have been obvious within the meaning of 35 U.S.C. ' 103 in view of Ausubel. As previously indicated, claims 2 through 4, 6 through 17, and 22 fall together with claim 1. The examiner=s decision, rejecting claims 1 through 4, 6 through 17, and 22 under 35 U.S.C. ' 103, is affirmed.

The examiner=s position to the contrary, notwithstanding, we conclude that the subject matter sought to be patented in claims 23 through 26 would not have been prima

facie obvious based on the combined disclosures of Ausubel and Laroche. For the reasons succinctly set forth in the Appeal Brief, page 5, lines 12 through 24, we hold that (1) the invention recited in claims 23 through 26 is not the result of A routine design choice@ given the combined disclosures of Ausubel and Laroche; and (2) the examiner=s rejection falls prey to the use of impermissible hindsight.

The examiner=s decision, rejecting claims 23 through 26 under 35 U.S.C. ' 103, is reversed.

In conclusion, the examiner=s decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR ' 1.136(a).

AFFIRMED-IN-PART

\_\_\_\_\_

SHERMAN D. WINTERS  
Administrative Patent Judge

WILLIAM F. SMITH  
Administrative Patent Judge

)  
)  
)  
)  
)  
)  
) BOARD OF PATENT  
)  
) APPEALS AND

Appeal No. 1996-2210  
Application 08/129,722

SDW/cam

HUBERT C. LORIN  
Administrative Patent Judge

)  
) INTERFERENCES  
)  
)  
)  
)

Appeal No. 1996-2210  
Application 08/129,722

Burton Rodney  
Bristol-Myers Squibb Company  
P. O. Box 4000  
Princeton, NJ 08543-4000